

## NOMINATIVE FAIR USE IN TRADEMARK LAW: REVISITED ONLINE, BUT WAS THE NINTH CIRCUIT'S ANALYSIS INVOKED FOR THE LAST TIME?

### I. INTRODUCTION

Suppose that you operate an Internet business that refers customers to other Internet service companies. The Internet companies operate by using certain trademarks. You use some of these trademarks in referring to the service companies. Is your use of the Internet service companies' trademarks on your website permitted under the law? The simple answer is: Yes. However, in answering the question above, ancillary questions that arise include (1) whether the use of another's mark on an e-commerce website for reference purposes constitutes trademark infringement, (2) whether the use on the accused infringer's website was in visible Internet content, invisible content, or the domain name, (3) whether a statutory trademark defense, such as fair use, permits such use, (4) whether a court recognizes any other defenses, such as nominative fair use, which permit such use, and (5) if nominative fair use is recognized, which test is the appropriate test of fairness? These considerations will be addressed against the backdrop of trademark with the Third Circuit's recently articulated nominative fair use analysis drawing the curtain over the Ninth Circuit's traditional nominative fair use analysis. Ultimately, the answers to these questions will shape the scope of use permitted to one Internet business using other companies' marks.

Further,

### II. DISCUSSION

#### A. TRADEMARK INFRINGEMENT

The lodestar of any trademark infringement analysis is the likelihood of confusion.<sup>1</sup> As the Lanham Act suggests, there are at least two species of confusion: confusion as to origin<sup>2</sup> or confusion as to sponsorship.<sup>3</sup> To determine whether there is indeed a likelihood of confusion, courts have generally applied an eight factor balancing test. Factors will typically include: (1) the strength of the mark; (2) similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the prior owner will bridge the gap; (5) actual confusion; (6) good faith; (7) the quality of the defendant's product; and (8) the sophistication of the buyers.<sup>4</sup>

In addressing trademark infringement on the Internet, courts continue to apply a likelihood of confusion test,<sup>5</sup> but have introduced different considerations in three general areas: the domain name,<sup>6</sup> visible Internet content,<sup>7</sup> and invisible Internet content.<sup>8</sup> *Brookfield*, the seminal Ninth Circuit case, addressed trademark infringement on the Internet via both the domain name and invisible content, in the metatags, of websites. Brookfield, an information provider, sought to enjoin a video rental store chain from using its "MovieBuff" trademark in the chain's website's domain name, "moviebuff.com," and metatags.<sup>9</sup> The court applied the *Sleekcraft* likelihood of confusion test and concluded that the plaintiff had demonstrated a likelihood of success on its claim that the defendant's use in its domain name of a mark confusingly similar to plaintiff's mark violated the Lanham Act.<sup>10</sup> The court then turned its attention to plaintiff's claims in the "metatag context," which it found to be different from the domain name context.<sup>11</sup> Eschewing the traditional test, the court noted that "the traditional [*Sleekcraft*] test is not well-suited for analyzing the metatags issue" and instead adopted the use of "initial interest confusion"<sup>12</sup> as a basis on which to find likelihood of confusion in the special context of metatags.<sup>13</sup>

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B. AFFIRMATIVE TRADEMARK DEFENSE: CLASSIC FAIR USE

Recognizing that “a trademark is a limited property right in a particular word, phrase or symbol,”<sup>14</sup> section 33 of the Lanham Act<sup>15</sup> sets forth fair use defenses under which one’s use of another’s mark may be permissible. “[T]rademark law recognizes a defense where the mark is used only to describe the goods or services of a party, or their geographic origin.<sup>16</sup> Just as trademark law forbids others from misappropriating a mark holder’s mark as his own,<sup>17</sup> fair use forbids a mark holder from misappropriating a descriptive term from others for his exclusive use.<sup>18</sup> This reasoning is no different in cyberspace; in the Internet context, fair use doctrine applies with as much force “as it does in the real world.”<sup>19</sup>

C. NOMINATIVE FAIR USE

1. THE *NEW KIDS* TEST

Believing the traditional likelihood of confusion test to be inappropriate for nominative fair use analysis, the Court of Appeals for the Ninth Circuit in *New Kids on the Block v. News America Pub., Inc.*<sup>20</sup> struck a new path in fair use analysis by distinguishing classic fair use or nominative fair use.<sup>21</sup> The Ninth Circuit considered whether the plaintiff’s rights in its trademarked name outweighed the rights of others to use it in identifying the plaintiff’s mark as the subject of public opinion polls.<sup>22</sup> Accordingly, the court held that “where the defendant uses a trademark to describe the plaintiff’s product, rather than its own, . . . a commercial user is entitled to a nominative fair use defense . . . .”<sup>23</sup>

Indeed, there may be situations where others have no alternative but to use the producer’s mark.<sup>24</sup> Where this is the case, the use of the producer’s mark may be allowed if the mark is “used only to describe the thing, rather than to identify its source.”<sup>25</sup> Put more generally, cases in which the nominative fair use defense may apply are situations “where the use of the trademark does not attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different one.”<sup>26</sup> To distinguish nominative fair use from classic fair use, the Ninth Circuit stated that:

“[i]f the defendant’s use of the plaintiff’s trademark refers to something other than the plaintiff’s product, the traditional fair use inquiry will continue to govern. But, where the defendant uses a trademark to describe the plaintiff’s product, rather than its own, we hold that a commercial user is entitled to a nominative fair use defense . . . .”<sup>27</sup>

Therefore, for the use to be considered a nominative fair use, the accused infringer must demonstrate that:

“(1) the product or service in question must be one not readily identifiable without use of the trademark; (2) only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and (3) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.”<sup>28</sup>

Following the *New Kids* case, its progeny have further illuminated the rationale behind nominative fair use doctrine. In *Playboy Enters. v. Welles*,<sup>29</sup> the Ninth Circuit explained why the three-factor test enunciated in *New Kids* “better evaluates in nominative use cases.”<sup>30</sup> The Ninth Circuit stated that “[w]hen a defendant uses a trademark nominally, the trademark will be identical to the plaintiff’s mark, at least in terms of the words in question.”<sup>31</sup> Accordingly, application of the traditional likelihood of confusion test<sup>32</sup> would errantly and automatically lead to the conclusion that “virtually all nominative uses are confusing.”<sup>33</sup> In the same year that *Welles* was decided, the Ninth Circuit decided *Cairns* where it refined the nominative and class

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fair use distinction.<sup>34</sup> “The nominative fair use analysis is appropriate where a defendant has used the plaintiff’s mark to describe the plaintiff’s product, *even if the defendant’s ultimate goal is to describe his own product.*”<sup>35</sup> Thus, *Cairns* expanded the class of cases under which nominative fair use may fall. “Conversely, the classic fair use analysis is appropriate where a defendant has used the plaintiff’s mark only to describe his own product, *and not at all to describe the plaintiff’s product.*”<sup>36</sup> A year later, the Ninth Circuit, in *Brother Records v. Jardine*,<sup>37</sup> further explained the nominative and classic fair use distinction.<sup>38</sup> Classic fair use applies when the accused infringer uses the mark in its primary, descriptive sense; alternatively, nominative fair use applies when the accused infringer uses the mark in its secondary, trademark sense.<sup>39</sup>

2. CENTURY 21 REAL ESTATE CORP. V. LENDINGTREE, INC.

Like many other Federal Courts of Appeals, the Court of Appeals for the Third Circuit had never encountered the nominative fair use issue prior to *Century 21 Real Estate Corp. v. Lendingtree, Inc.*<sup>40</sup> In *Century 21*,<sup>41</sup> the Third Circuit considered the proper test to apply where a defendant asserts a nominative fair use defense to a claim of trademark infringement under the Lanham Act.<sup>42</sup>

Century 21, ERA and Coldwell Banker oversaw a system of franchisees that operated by reference to the franchisor’s trademark.<sup>43</sup> Franchise agreements permitted those brokerage companies to provide realty services under trademarks held by Cendant Corporation.<sup>44</sup> Every franchisee was granted a license to use its franchisor’s trademark only in connection with its “d/b/a” name.<sup>45</sup> LendingTree (“LT”) was an Internet business that helped consumers identify and select qualified lenders, real estate brokers, auto insurers, and other financial service companies.<sup>46</sup> It had a real estate referral service that consumers can access by visiting its website and inputting the location and characteristics of the house they are seeking to buy or sell.<sup>47</sup> LT selected and transmitted information about up to four real estate companies participating in LT’s referral network that service that community.<sup>48</sup>

The issue presented to the district court was the use of Cendant Corporation’s marks on LT’s webpage.<sup>49</sup> The district court determined that LT’s use of Cendant Corporation’s names was likely to cause consumer confusion, that the nominative use defense did not shield LT in this instance, and thus, granted CCE’s motion for a preliminary injunction as to the use of some of Cendant Corporation’s marks.<sup>50</sup> Subsequently, LT appealed the issuance of the preliminary injunction.<sup>51</sup>

In reversing the lower court’s decision, the Court of Appeals for the Third Circuit expressly rejected the Ninth Circuit’s nominative fair use analysis.<sup>52</sup> In departing from the Ninth Circuit Court of Appeal’s nominative fair use analysis, the Third Circuit first reasoned that classic and nominative fair use were not so different as to call for a different approach.<sup>53</sup> The Third Circuit next reasoned that the Ninth Circuit Court of Appeal’s approach would unfairly benefit the plaintiff in not requiring likelihood of confusion as a predicate to the defendant’s assertion or demonstration of nominative fair use.<sup>54</sup> Accordingly, the Third Circuit held that under the circumstances of the case, the proper analysis involves a bifurcated inquiry.<sup>55</sup> First, the plaintiff must demonstrate the likelihood of confusion in defendant’s use of plaintiff’s mark.<sup>56</sup> Second, only upon plaintiff meeting its burden, the defendant must demonstrate that its nominative use of plaintiff’s mark is nonetheless fair.<sup>57</sup> To demonstrate fairness, the accused infringer must show three elements:

“(1) that the use of plaintiff’s mark is necessary to describe both the plaintiff’s product or service and the defendant’s product or service; (2) that the defendant

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uses only so much of the plaintiff's mark as is necessary to describe plaintiff's product; and (3) that the defendant's conduct or language reflect the true and accurate relationship between plaintiff and defendant's products or services.”<sup>58</sup>

3. CLASSIC AND NOMINATIVE FAIR USE IN OTHER CIRCUIT  
COURTS

The Ninth Circuit understandably remains the most fluent in nominative fair use doctrine.<sup>59</sup> Indeed, only the Second, Fifth and Sixth Circuits have acknowledged the nominative fair use defense.<sup>60</sup> The Sixth Circuit has definitively rejected the Ninth Circuit's approach. In *PACAAR Inc. v. TeleScan Technologies, L.L.C.*,<sup>61</sup> the Sixth Circuit stated that “[t]his circuit has never followed the nominative fair use analysis, always having applied the Frisch's Restaurants test. We are not inclined to adopt the Ninth Circuit's analysis here.”<sup>62</sup> The Fifth Circuit has only partially adopted the Ninth Circuit's nominative fair use analysis.<sup>63</sup> In *Pebble Beach*, the Fifth Circuit only required of the defendant asserting a nominative fair use to demonstrate (1) only so much of the mark as necessary to identify the product or service was used and (2) the absence of suggestion of affiliation, sponsorship, or endorsement.<sup>64</sup> The Second Circuit eminently illustrates the difficulties in nominative fair use. In *Chambers v. Time Warner, Inc.*,<sup>65</sup> the Second Circuit noted that the district court had applied the standard for nominative fair use as articulated by the Ninth Circuit, but found that the lower court had erred in its application.<sup>66</sup> Despite the ostensible approval of the Ninth Circuit's nominative fair use analysis, the Second Circuit, in *Courtenay Communs. Corp. v. Hall*,<sup>67</sup> cited in a footnote to the Fifth Circuit's *Pebble Beach* test rather than to the Ninth Circuit's *New Kids* test.<sup>68</sup>

4. NOMINATIVE FAIR USE: THE PROPER TEST

i. CLASSIC AND NOMINATIVE FAIR USE SHOULD NOT  
REQUIRE DIFFERENT ANALYSES

When an accused infringer asserts a nominative fair use defense, first, the court should first determine whether the plaintiff has demonstrated a likelihood of confusion and second, determine whether the use is fair. In *Century 21*, the Third Circuit justified its rejection of the *New Kids* test on two grounds. In addition to recognizing that classic and nominative fair uses are indeed different, the Third Circuit also recognized that both classic and nominative fair use analyses shared a significantly common component.<sup>69</sup> In either classic or nominative fair use cases, the defendant uses the plaintiff's mark in a way that confuses consumers. In the classic case, the consumer is confused as to whether the defendant's products are the same as the plaintiff's products. However, in the nominative case, the consumer is confused as to whether the plaintiff sponsors or endorses defendant's use of plaintiff's mark.

Indeed, several years following *Cairns*, the Ninth Circuit, in *Brother Records, Inc. v. Jardine*,<sup>70</sup> added another wrinkle to classic and nominative fair use distinction. The Ninth Circuit noted that, sometimes, the defendant's title may simultaneously be the plaintiff's mark.<sup>71</sup> The Court admitted that in a case like this, the Ninth Circuit's nominative and classic fair use distinction may be problematic.<sup>72</sup> Further, the Ninth Circuit noted that: “[w]here the defendant uses his or her own title, which happens to be plaintiff's trademark, defendant can argue convincingly both that the use refers to defendant and that the use refers not at to defendant.”<sup>73</sup> Accordingly, the Ninth Circuit tacitly acknowledges that the Ninth Circuit's reliance on the target of description distinction<sup>74</sup> may not be as robust a distinction to justify jettisoning the likelihood of confusion test.

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ii. LIKELIHOOD OF CONFUSION IS ESSENTIAL TO TRADEMARK  
INFRINGEMENT ANALYSIS

The Third Circuit also justified its conclusion on the ground that likelihood of confusion should remain a principal component of the nominative fair use analysis. The Third Circuit explained that the Ninth Circuit's approach would place the initial burden on the defendant without ever requiring of the plaintiff to prove one of the "key elements of a trademark infringement case."<sup>75</sup> The court pointed to the statute<sup>76</sup> itself as well as the Supreme Court's decision in *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 120 (2004).<sup>77</sup> The Third Circuit reasoned that the language of the Lanham Act compels the conclusion that likelihood of confusion is essential to determining whether trademark infringement has occurred.<sup>78</sup> The Lanham Act forbids use of words or marks in a way which is likely to cause confusion as to the origin, sponsorship, or approval of goods or services.<sup>79</sup> Accordingly, the Third Circuit opted not "to read this requirement out of a case alleging trademark infringement."<sup>80</sup>

In *KP Permanent Make-Up*, the Supreme Court held that: "A party raising the statutory affirmative defense to a claim of trademark infringement does not have a burden to negate any likelihood that the practice complained of will confuse consumers about the origin of the goods or services affected."<sup>81</sup> The Supreme Court rejected the notion that, in the context of classic fair use, the party asserting the fair use defense to a claim of trademark infringement had any burden to negate the likelihood that the practice complained of will confuse consumers about the origin of the services or goods affected.<sup>82</sup> In explaining that "the burden of proving likelihood of confusion rests with the plaintiff[] and the fair use defendant has no free-standing need to show confusion unlikely," the Supreme Court held that "some possibility of consumer confusion must be compatible with fair use."<sup>83</sup>

D. ANALYSIS

On balance of the foregoing principles and discussion, a website may use another's mark to describe the trademark holder's product or services. However, permission requires that the website using another's trademark limit its use within the rubric of non-confusing, fair use. In other words, an accused infringer's use may be permitted if (1) there is no likelihood of confusion; or (2) there is a likelihood of confusion, but the use is fair.

Accordingly, to impose liability upon an accused infringer whose e-commerce website references another's mark, the mark holder must demonstrate that a balancing of these factors would lead to a likelihood of confusion as to origin or sponsorship. Even in the Internet context, the likelihood of confusion remains of paramount concern in trademark infringement analysis. In the internet context, one court has noted, the three most important of these factors are: (1) the similarity of the marks; (2) the relatedness of the goods or services; and (3) the "simultaneous use of the Web as a marketing channel."<sup>84</sup>

Indeed, in the Internet context, use of a trademark in invisible content, like metatags, visible content, like HTML code, or the domain name may trigger different considerations to accurately evaluate the likelihood of confusion. Along those lines, the use of another's trademark on web pages, has been found to infringe those trademarks<sup>85</sup> and in other cases has been found non-infringing.<sup>86</sup> The use of trademarks in website headlines and banner advertisements has been held to be a nominal fair use and, therefore, not infringing.<sup>87</sup> And the use of another's trademarks in website wallpaper has been held not to be a nominal fair use.<sup>88</sup>

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Trademark infringement notwithstanding, the accused infringer’s liability will also require weighing the merits of asserted defenses. To that end, an accused infringer whose e-commerce website references another’s mark may avoid liability by demonstrating that its use of the mark was fair. However, no consensus exists among the federal courts as to the proper approach when an accused infringer asserts a nominative fair use defense. Specifically, whether an accused infringer is permitted to use another’s mark to refer to the mark holder remains unsettled law. Whether the use of another’s trademark constitutes a fair use, classic or nominative, and, therefore, non-infringing appears to depend on whether the use is (1) necessary to describe the mark holder’s goods or services; (2) only so much as necessary; and (3) not misleading.<sup>89</sup>

### III. CONCLUSION

While it is lawful for a website to use another’s trademark to reference the trademark holder, permission is not absolute. Because the issue of which trademark infringement analysis should be followed when an accused infringer asserts a nominative fair use defense, the scope of a website operator’s use of another’s trademark remains nebulous. Notwithstanding this uncertainty, the factors courts use in determining a likelihood of confusion provide at a minimum an area of fair use permissible by trademark law. So long as a website’s use of a trademark remains within this ambit of permissibility, its use will remain lawful.

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<sup>1</sup> See 15 U.S.C. § 1125. Section 43(a) of the Lanham Act provides that: “(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) *is likely to cause confusion*, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or *as to the origin, sponsorship, or approval* of his or her goods, services, or commercial activities by another person . . .

. . .

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.”

*Id.* (emphasis added).

<sup>2</sup> See *id.* The use of a registered mark is not prohibited if the use is intended merely to refer to the holder of the mark.

*Prestonettes, Inc. v. City*, 264 U.S. 359, 44 S.Ct. 350, 68 L.Ed. 731 (1924). Justice Holmes permitted the use of plaintiff’s mark by the defendant under the condition that the defendant not pass off defendants’ goods as the plaintiff’s.

<sup>3</sup> See 15 U.S.C. § 1125; *WCVB-TV v. Boston Athletic Ass’n*, 926 F.2d 42 (1st Cir. 1991) (permitting television station’s use of name “Boston Marathon” to describe that event so long as there was no likelihood of confusion as to plaintiff’s sponsorship or imprimatur of the station’s broadcast)

<sup>4</sup> See e.g. *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (applying an eight factor test); *Frisch’s Rests., Inc. v. Elby’s Big Boy of Steubenville, Inc.*, 670 F.2d 642, 648 (6th Cir.) (applying an eight factor test); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (applying an eight factor test).

<sup>5</sup> See c.f. Anticybersquatting Consumer Protection Act (the “ACPA”), 15 U.S.C. § 1125(d). In 1999, Congress passed legislation to address the “uncertainty as to the trademark law’s application to the Internet [which] has produced inconsistent judicial decisions and created extensive monitoring obligations, unnecessary legal costs, and uncertainty for consumers and trademark owners alike.” *Id.* The ACPA created a statutory remedy for trademark violations in the registration, trafficking, or use of a domain name. *Id.*

<sup>6</sup> *Brookfield Communications v. West Coast Entm’t*, 174 F.3d 1036, 1041-43 (9th Cir. 1999).

<sup>7</sup> *Playboy Enters. v. Welles*, 279 F.3d 796, 801; see *id.*

<sup>8</sup> *Welles*, 279 F.3d at 801.

<sup>9</sup> See *Brookfield*, 174 F.3d at 1041-43.

<sup>10</sup> *Id.* at 1061.

<sup>11</sup> *Id.* at 1062.

<sup>12</sup> Initial interest confusion refers to the use of another’s trademark in a manner calculated “to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion, may be still an infringement.” *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997), petition for cert. dismissed by, 118 S. Ct. 27 (1997)

<sup>13</sup> *Brookfield*, 174 F.3d at 1062, n.24, 1062--1065.

<sup>14</sup> *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 306 (9th Cir. 1992).

<sup>15</sup> 15 U.S.C. § 1115.

<sup>16</sup> *Id.* at 306.

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<sup>17</sup> *Id.* at 305.

<sup>18</sup> *Id.* at 306.

<sup>19</sup> *Brookfield*, 174 F.3d at 1065.

<sup>20</sup> 971 F.2d 302, 308 (9th Cir. 1992)

<sup>21</sup> *New Kids*, 971 F.2d at 308.

<sup>22</sup> *Id.* at 304.

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*; see *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350 (9th Cir. 1969) (holding that Volkswagen could not prevent an automobile repair shop from using its mark).

<sup>25</sup> *New Kids*, 971 F.2d at 306. In other words, the nominative use of the mark may be excused because the “source-identification function” is not implicated by its use. See *id.*

<sup>26</sup> *Id.* at 307-08.

<sup>27</sup> *Id.* at 308.

<sup>28</sup> *Id.*

<sup>29</sup> 279 F.3d 796, 801 (9th Cir. 2002).

<sup>30</sup> *Id.*

<sup>31</sup> *Id.*

<sup>32</sup> In the Ninth Circuit, the likelihood of confusion test is found in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979). The *Sleekcraft* factors are: (1) strength of the mark; proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product lines. *Id.*

<sup>33</sup> *Welles*, 279 F.3d at 801.

<sup>34</sup> 292 F.3d at 1151.

<sup>35</sup> *Id.* (emphasis in original).

<sup>36</sup> *Id.* (emphasis in original).

<sup>37</sup> 318 F.3d 900 (9th Cir. 2003).

<sup>38</sup> *Id.* at 906.

<sup>39</sup> *Id.* at 906-07.

<sup>40</sup> 425 F.3d 211 (3d Cir. 2005).

<sup>41</sup> *Id.*

<sup>42</sup> *Id.* at 215.

<sup>43</sup> *Id.* For example, “Century 21 Smith Realty.”

<sup>44</sup> *Id.*

<sup>45</sup> *Id.* A franchisee could only refer to itself as “Century 21 Smith Realty” and not just “Century 21.”

<sup>46</sup> *Id.*

<sup>47</sup> *Id.*

<sup>48</sup> *Id.*

<sup>49</sup> *Id.* at 216.

<sup>50</sup> *Id.*

<sup>51</sup> *Id.*

<sup>52</sup> *Id.* at 222.

<sup>53</sup> *Id.* at 220.

<sup>54</sup> *Id.* at 221.

<sup>55</sup> *Id.*

<sup>56</sup> *Id.*

<sup>57</sup> *Id.* at 222.

<sup>58</sup> *Id.*

<sup>59</sup> See also *Mattel Inc. v. Walking Mt. Prods.*, 353 F.3d 792 (9th Cir. 2003) (applying nominative fair use defense to trade dress infringement analysis).

<sup>60</sup> *Chambers v. Time Warner, Inc.*, 282 F.3d 147, 156 (2d Cir. 2002); *Courtenay Communs. Corp. v. Hall*, 334 F.3d 210 (2d Cir. 2003); *Weight Watchers Int’l v. Luigino’s, Inc.*, 423 F.3d 137, 143 (2d Cir. 2005);

*Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 546 n. 13 (5th Cir. 1998); *Waco Int’l, Inc. v. KHK Scaffolding Houston, Inc.*, 278 F.3d 523 (5th Cir. 2002); *Interactive Products Corp. v. Azz Mobile Office Solutions, Inc.*, 326 F.3d 687, 698 n.6 (6th Cir. 2003); *PACAAR Inc. v. TeleScan Technologies, L.L.C.*, 319 F.3d 243, 256 (6th Cir. 2003).

<sup>61</sup> 319 F.3d 243, 256 (6th Cir. 2003).

<sup>62</sup> *Id.*; see *Interactive Products Corp. v. Azz Mobile Office Solutions, Inc.*, 326 F.3d 687, 698 (6th Cir. 2003) (discussing a cited case, which relied on the Ninth Circuit’s nominative fair use doctrine, only in order to illustrate plaintiff’s misplaced reasoning).

<sup>63</sup> *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 546 (5th Cir. 1998); *Waco Int’l, Inc. v. KHK Scaffolding Houston, Inc.*, 278 F.3d 523, 534 (5th Cir. 2002) (affirming the *Pebble Beach* test).

<sup>64</sup> *Pebble Beach Co.*, 155 F.3d at 546.

<sup>65</sup> 282 F.3d 147, 156 (2d Cir. 2002).

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<sup>66</sup> *Id.*

<sup>67</sup> 334 F.3d 210, 214 (2d Cir. 2003).

<sup>68</sup> *Id.* (seemingly retreating from its approval of the Ninth Circuit’s *New Kids* test).

<sup>69</sup> *Id.* at 223.

<sup>70</sup> 318 F.3d 900 (9th Cir. Cal. 2003).

<sup>71</sup> *Id.* at 904.

<sup>72</sup> “In these situations, the reference-to-trademark-holder distinction often proves more frustrating than helpful.” *Id.* at 905.

<sup>73</sup> *Id.* at 905.

<sup>74</sup> The target of description distinction refers to the distinction between using a mark to describe the defendant’s goods or services and to describe the plaintiff’s goods or services.

<sup>75</sup> *Century 21*, 425 F.3d at 221.

<sup>76</sup> §§ 32 and 43 of the Lanham Act, 15 USC §§ 1115, 1125.

<sup>77</sup> *Century 21*, 425 F.3d at 221.

<sup>78</sup> *Century 21*, 425 F.3d at 221.

<sup>79</sup> See 15 U.S.C. § 1125.

<sup>80</sup> *Century 21*, 425 F.3d at 221.

<sup>81</sup> *KP Permanent Make-Up*, 543 U.S. at 120.

<sup>82</sup> *Id.* at 121.

<sup>83</sup> *Id.*

<sup>84</sup> *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1205 (9th Cir. 2000)

<sup>85</sup> See e.g. *Courtenay*, 334 F.3d at 214; *Chambers*, 282 F.3d at 156; *GoTo*, 202 F.3d at 1210.

<sup>86</sup> See e.g. *Welles*, 279 F.3d at 801.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> These considerations attempt to reconcile the similar concerns of the *New Kids* test and the *Century 21* fairness factors.

Moreover, the inclusion of a disclaimer disclaiming any association to the trademark holder could arguably bolster the accused infringer’s claim. See *Welles*, 279 F.3d at 799.